

REMARKS

This is in response to the Official Action mailed February 12, 2002 in the above-referenced application. Claims 1-37 are currently pending. Claims 2-37 have been cancelled without prejudice. Claim 1 has been amended. New Claims 53-57 have been added.

The issues raised in the Official Action are discussed below in the order set forth therein.

35 U.S.C. § 112, Second Paragraph

Claim 37 stands rejected under 35 U.S.C. § 112, second paragraph. Claim 37 has been cancelled without prejudice.

Claim Rejections under 35 U.S.C. § 102

Claims 1-3, 5-7, 10-13, 15-16 and 37 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ruys (1993). The Ruys reference was cited during the prosecution of the commonly owned patent application, which issued as U.S. Patent No. 6,323,146. In order to further the prosecution of the present application, Claim 1 has been amended to recite a composition comprising a bioresorbable biomaterial compound comprising calcium, oxygen and phosphorous, wherein a portion of at least one of said elements is substituted with an element having an ionic radius of approximately 0.1 to 0.6Å and a pharmaceutical agent. As such, Ruys does not teach each and every limitation of the claim and therefore does not anticipate the claim. Basis for the amendment may be found on page 24, line 33 to page 25, line 12 of the specification, and elsewhere within the specification, as originally filed.

Claims 2-37 have been cancelled without prejudice.

Double Patenting

Claims 1-37 stand under the judicially created doctrine of double patenting over Claims 1, 2, 4-6, 8, 14, 15, 18, 19, 20, 21 and 22 of Applicant's U.S. Patent No. 6,323,146. Claim 1 has been amended to overcome this rejection. Claims 2-37 have been cancelled, without prejudice. Claims 53-57 have been added to further clarify the invention. As such, the claims are directed

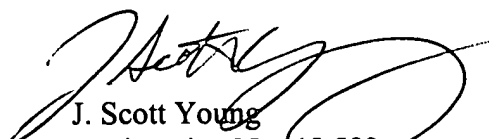
to a different embodiment not encompassed by the claims of the '146 patent. Basis for the added claims may be found in the specification and claims as originally filed. No new matter has been added.

Conclusions

Applicants respectfully submit that the claimed invention is novel and accordingly request withdrawal of all the rejections under 35 U.S.C. §§ 102(a) and (b). In view of these submissions, the Applicants respectfully request an allowance of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,


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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231, on July 9, 2002.


Janet F. Moore

Version with Markings to Show Changes Made:

In the Claims:

1. (Amended) A biomaterial composition comprising:
[A] a bioresorbable biomaterial compound comprising calcium, oxygen and phosphorous, wherein a portion of at least one of said elements is substituted with an element having an ionic radius of approximately 0.1 to 0.6Å [1.1Å.]; and
a pharmaceutical agent.